

REMARKS

Applicant respectfully requests entry of the remarks submitted herein. The claims were not amended herein. Claims 1 and 2 are currently pending. Reconsideration of the pending claims is respectfully requested.

The 35 U.S.C. §103 Rejections

Claim 1 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Helmbrook et al. (US 2002/0042375) in view of Kim et al. (2002, *Am. J. Path.*, 160:219-26); and claim 2 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Helmbrook et al. and Kim et al. further in view of Nakao et al. (US 2002/0107273). According to the Examiner, the “decrease in expression, the transactivating activity ability, and/or the IL6-mediated activation of the androgen receptor [that] indicates an inhibitory activity effect by the NSAID on the proliferation of cancer cells” recited in claim 1 is a characteristic that was already present in the prior art, even though it was not recognized at the time. The Examiner asserted that the “discovery of an previously unappreciated property of a prior art composition, or of a scientific explanation for the prior art’s functioning, does not render the old composition patentably new to the discoverer” and cited MPEP §2112. Applicants respectfully traverse these rejections.

As indicated previously, the present invention is predicated on the discovery of the mechanism of action of NSAIDs with respect to inhibiting the proliferation of prostate cancer cells. As described in the specification, NSAIDs inhibit prostate cancer cells by decreasing the expression of the androgen receptor, the transactivating ability of the androgen receptor, and/or the IL6-mediated activation of the androgen receptor. Applicant does not dispute that the effect of NSAIDs on the expression of the androgen receptor, the transactivating ability of the androgen receptor, and/or the IL6-mediated activation of the androgen receptor may have been an inherent property of prostate cells exposed to NSAIDs. However, the pending claims require an active step of “determining the level of expression, the transactivating ability, and/or the IL6-mediated activation of an androgen receptor.” Since the mechanism of action of NSAIDs on prostate cancer cells was not known prior to the instant disclosure, the active step of “determining the level of expression, the transactivating ability, and/or the IL6-mediated activation of an androgen receptor” was not inherent in the references cited by the Examiner. In

fact, there is no disclosure in any of the references cited by the Examiner that would prompt one of skill in the art to determine the level of expression, the transactivating ability, and/or the IL6-mediated activation of an androgen receptor.

The claimed methods are not obvious over the combination of Helmbrook et al., Kim et al. and Nakao et al. In view of the remarks herein, Applicant respectfully requests that the rejection of claims 1 and 2 under 35 U.S.C. §103(a) be withdrawn.

CONCLUSION

Applicant respectfully requests allowance of claims 1 and 2. Please apply any charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

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